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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,193	08/01/2001	Simon Smith	BAI525-455/01633	3977

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EXAMINER

WONG, LUT

ART UNIT	PAPER NUMBER
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2129

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/919,193

Applicant(s)

SMITH ET AL.

Examiner

Lut Wong

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This office action is responsive to an AMENDMENT entered Nov 7, 2006 for the patent application 09/919193.

Status of Claims

Claims 1-19 are pending. Claims 1, 6 have been amended. Claim 20 has been withdrawn.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Drawings

The replacement sheets for fig. 3-5 are accepted by the examiner.

The drawings are objected to because it is difficult to read the text in figure 1, especially "knowledge Activation" box. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after

Art Unit: 2129

the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, e.g. the steps of creating a process model, associating, auditing and tracing, mapping...etc that are performed in claims 1, 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 2129

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains legal phraseology "said". It also contains implied phrase "The present invention relates..." Correction is required. See e.g. MPEP § 608.01(b).

Content of Specification

- (b) **Cross-References to Related Applications:** See e.g. 37 CFR 1.78 and MPEP § 201.11.
- (g) **Brief Summary of the Invention:** See e.g. MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in

general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

The disclosure is objected to because of the following informalities:

1. The usage of legal phraseology such as "said" should be avoided.
2. pg. 4, add the application number of the co-pending patent application. Also, co-pending application should be added to the cross-references section to Related Applications in the disclosure.
3. Summary of the Invention should be a brief and general statement that points out the advantages of the invention.
4. Appropriate correction is required.

Claim Objections

Claims 1, 6, 7, 10, 11, 17-19 are objected to because of the following informalities:

Claim 1: change "knowledge resources;" to "knowledge resources,"

Claim 6: change "said model accessible" to "said model being accessible"

Claim 6: change "to be effective," to "to be effective;"

Claim 7: change "Claim 6" to "claim 6"

Claim 7: change "PC" to "Personal Computer (PC)"

Claim 10: delete "(" and ")" in line 2

Claim 11: delete "in conjunction" in line 2

Claims 17-19: change "elements and revealed" to "elements are revealed"

Appropriate correction is required.

Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 is drawn to revealing resource to a user upon selection, and made the resource accessible to the user. Claim 17 fails to further limit claim 11 because such limitation are presented in claim 11 already.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "appropriate point" in **claims 1 and 6** is a relative term which renders the claim indefinite. The term "appropriate point" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. I.e. What point is considered as appropriate?

The term "relevant" in **claims 1 and 6** is a relative term which renders the claim indefinite. The term "relevant" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. I.e. What degree is considered as relevant?

Claims 1 and 6 recite the limitation "within the modeling tool". There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites "generating a process-driven knowledge activation system comprising said one or more symbols or textual representation of said symbols associated with said processes linked to said knowledge resource". It is not clear what applicant is intended to claim. It is presume to mean "generating a process-driven knowledge activation system comprising one or more said symbols or textual representation of said symbols, wherein said symbols are associated with said processes, wherein said processes are linked to said knowledge resource" for the purpose of compact prosecution.

Claim 6 recites the limitation "the resources" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "across the model" in line 7. It is not clear what model is referring to: the process model or the business model? It is presumed to mean process model for future reference.

Claim 6 recites the limitation "named links". There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "A process model according to claim 6 wherein the knowledge resources are accessed by the user selection of one or more of the symbols or links representing these resources from within the process model or definition and an appropriate display is generated for any associated knowledge resource." It is not clear what applicant is intended to claim. It is presumed to mean "when an element is selected, an appropriate display is generated for any associated knowledge resource."

Claims 7-10 recite "A process model according to claim 6". There is insufficient antecedent basis for this limitation in the claim. Claim 6 is a method claim, not a model claim.

Claim 13 recites "upon selection of an element if there are any resources linked thereto in the model, the same are represented on the display screen and thereafter selectable by the user". It is not clear what "the same" is referring to. It is also not clear what applicant is intended to claim. It is presumed to mean "upon selection of an element, the resources are displayed on the screen and made selectable if the resources are available."

Claim 15 recites "A model according to claim 14 wherein the selected resources can only be accessed by the user via the business or process model and the prior selection of an element of the same". It is not clear what "the same" is referring to. It is also not clear what applicant is intended to claim. Claim 15 is interpreted as "A model according to claim 14 wherein the selected resources can only be accessed by the user via the business or process model." For the purpose of compact prosecution.

Claim 16 recites the limitation "wherein the usage of the elements". There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "by the model administrator". There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "wherein said model graphically represented on a display screen". There is insufficient antecedent basis for this limitation in the claim.

Claims 17-19 recite the limitation "wherein said model graphically represented on a display screen and including a series of model elements and a series of resources, said resources, or representations thereof linked to elements and revealed to the user upon the user selecting an element, the associated resources then presented to the user for selection, and, upon selection, accessible to the user." It is not clear what applicant is intended to claim. It is presumed to mean "the resource are revealed and made accessible to the user upon user selection" for the purpose of compact prosecution.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim 7 recites "any conventional PC based user control system". The term "any" renders the claim indefinite because it fails to point out what PC is included or excluded by the claim language.

Claim 8 recites "any associated knowledge resource". The term "any" renders the claim indefinite because it fails to point out what resource is included or excluded by the claim language.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-17 are drawn to a business model or a process model. A model is not a process, machine, manufacture, or composition of matter. As such, it fails to fall within a statutory category and thus non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (US 7171647). The applied reference has a common inventor and

assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1 and 6: Smith anticipates a method for creating a process-driven knowledge activation system (See e.g. abstract), said method comprising the following steps: creating a process model comprising one or more elements (See e.g. Fig. 1, C3 L55 - C4 L26); associating at appropriate points within processes in said model a collection of symbols representing the resources that will be required by a user to be effective (associating element with software components. See e.g. Fig. 1, C3 L55 - C4 L26); auditing and tracing the usage of said symbols across the model being auditable through a mechanism of dependency analysis within the modeling tool (reviewing and Microsoft Visual InterDev. See e.g. Fig. 1, C3 L55 - C4 L26); mapping said symbols associated with the process that requires them to electronically-stored knowledge resources (mapping and storing. See e.g. Fig. 1, C3 L55 - C4 L26); generating a process-driven knowledge activation system comprising said one or more symbols or textual representation of said symbols associated with said processes linked to said knowledge resources (resulting PSIM system. See e.g. Fig. 1, C3 L55 - C4 L26); said system revealing to the user, through a graphical user interface, on clicking on a process, the associated relevant knowledge resource symbols or textual representation

of said symbols, the appropriate resource then being presented to the user on the click of said symbols or textual representation of said symbols (using the resulting PSIM system. See e.g. Fig. 1, C3 L55 - C4 L26); and repeating periodically the above steps in a review cycle in which the process models and resources of the process driven knowledge activation system are revised and re-published (See e.g. Fig. 1, C3 L55 - C4 L26).

Claim 2: note that the process model is part of a set of general purpose graphical business models (See e.g. C2 L30-C3 L20, especially C2 L45).

Claim 3: note that the process models are accessible via a web browser (See e.g. C2 L30-C3 L20, especially C2 L55).

Claim 4: note that the one or more elements of the process model are provided in a tool which uniquely identifies each element and maps each element to the one or more knowledge resources (See e.g. C2 L30-C3 L20, especially C2 L55-60).

Claim 5: note that the knowledge resource symbols can be queried within a tool to ascertain for each, the set of processes with a requirement of said symbol's corresponding resource, so facilitating a process of resource change management (See e.g. fig. 4).

Claim 7: note that the process model is illustrated on a display screen and the elements can be selected by any conventional PC based user control system (See e.g. C2 L30-C3 L20, especially C2 L50).

Claim 8: note that the knowledge resources are accessed by the user selection of one or more of the symbols or links representing these resources from within the

Art Unit: 2129

process model or definition and an appropriate display is generated for any associated knowledge resource (See e.g. C2 L30-C3 L20, especially C2 L52-53).

Claim 9: note that a modeler/user follows the method to create a set of general purpose graphical business models containing various linked elements in a tool, said tool able to generate models which are accessible via a web browser and which links the knowledge resource symbols in the browser by uniquely identifying each element and its corresponding web page (See e.g. C2 L30-C3 L20, especially C2 L60-67).

Claim 10: note that the model maps knowledge resource symbols associated with a process that requires them to their corresponding knowledge resources (See e.g. C2 L30-C3 L20, especially C3 L2-3).

Claims 11-17: See e.g. the 101 rejections above. See e.g. also Fig 1 for the model.

Claims 18-19: note that the resource are revealed and made accessible to the user upon user selection (See e.g. C2 L30-C3 L20, especially C2 L45-55)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See e.g., e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6 are rejected on the ground of nonstatutory double patenting over claims 1-3 of U. S. Patent No. 7171647 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claim scope of the U.S patent is limited to software application while the claim scope of instant application is any application. Hence, the claim scope of instant application is broader than the U.S patent 7171647, and the claim limitations are anticipated.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See e.g. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See e.g. also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by an online press release article (“powerful business transformation partnership enabling sustainable growth in e-business”) which dates back to July 2000 at <http://web.archive.org/web/20000712093414/www.tsorg.com/pressrelease.htm>, as evidenced by Smith et al (US 7171647).

Claims 1-19 are drawn to a method for creating a process driven knowledge activation system by using Mood. The method comprise creating a process model, linking the model with resource, and using the model.

Mood has been disclosed in the press release. Mood has also been disclosed in a U.S Patent by Smith et al (See e.g. C3 L 55-65 and Figs 2-10). Smith et al is an evidential reference to show that Mood disclosed in the press release is inherently capable of anticipating claims 1-19. See the rejections by Smith et al above.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lut Wong whose telephone number is (571) 270-1123. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent David can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2129

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lut Wong
Patent Examiner AU 2129



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SUPERVISORY PATENT EXAMINER